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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/486,977	03/06/2000	MARK HANS EMANUEL		6804

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EXAMINER

BUI, VY Q

ART UNIT	PAPER NUMBER
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3734

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/486,977	Applicant(s) EMANUEL, MARK HANS	
	Examiner Vy Q. Bui	Art Unit 3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-71 is/are pending in the application.
- 4a) Of the above claim(s) 24-37, 39-56, 58, 60 and 62-67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20, 21, 38, 57, 59, 61 and 68-71 is/are rejected.
- 7) ☐ Claim(s) 22 and 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I (claims 20-23, 38, 57, 59, 61 and 68-71) in the reply filed on 3/27/2006 is acknowledged. Other claims directed to the invention of Group II are withdrawn from further consideration.

The traversal is on the ground(s) that it would not be a serious burden for the Examiner to examine both Group I and Group II inventions. This is not found persuasive because the invention of Group II (endoscope) requires further searches to cover at least class 600/103, 109, 152, 154 and 156, which include more than a thousand of patents about endoscope devices.

Previously, the Examiner was able to reject the claims in Group II invention because the claims were broad and easy to reject. However, it would be a serious burden for the Examiner to examine the invention of Group II without serious further searches and consideration.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 20-21, 59 and 68 are rejected under 35 U.S.C. 102(b) as being anticipated by or alternatively obvious over KAGAWA et al (5,163,433).

As to claims 20-21, 59 and 68, KAGAWA (Fig. 1, for example) discloses a cutting device/probe 3 for removal of tissue from a body cavity in a human being (column 1, lines 11-

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16) including lumen 21 of cutting device/probe 3 extending to end 15, which defines a first suction passage/first path 21 for discharging fluid with detached tissue, an outer tube 22b, an inner tube 22a, fluid pump 42 and suction pump 41. Probe 3 and inner tube 22a define fluid supply passage 25, inner tube 22a and outer tube 22b defines fluid passage 26/second path for discharging substantially only fluid because the suction mouth of the discharge passage 26 is next to the supply mouth of the supply passage 25 (see Fig. 1).

Notice that first path and second path as indicated above are completely separate and first and second source of suction is the suction pump 41. Further, to avoid over flow of the body cavity, the fluid supplied from passage 25 and fluid discharged through passages 21 and 26 must be regulated so as to keep a balance between inflow fluid from passage 25 and outflow fluid through passages 25 and 26. Therefore, the pressure in the cavity body would be substantially constant.

Further, Kagawa (col. 1, lines 11-16) discloses the device is used for fracturing a stone in a body cavity (such as a bladder) or for resection of living tissue in another body cavity (such as a knee joint cavity). Inherently, a body cavity/body organ (such as a bladder, a peritoneum or even a knee joint cavity) is distensible. Alternatively, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the Kagawa device for cutting a tissue in a distensible body organ defining a body cavity, as this device is disclosed to be used in any body cavity.

KAGAWA device inherently discloses a method of discharging fluid with detached tissue through a first path (passage 21 as indicated above) and discharging substantially only fluid along a second path (passage 26 as indicated above) so as to regulate the pressure in the body cavity to remain substantially constant. Alternately, to avoid over flow of fluid from the body cavity, it would have been obvious to one of ordinary skill in the art at the time of the invention to

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regulate the KAGAWA device a in a method as recited in the claims such that the inflow fluid from passage 25 into the body cavity and the discharge fluid through passages 25, 26 out of the body cavity are regulated to control a pressure in the body cavity under operation or keep the pressure inside the body cavity substantially constant to avoid a bursting of the cavity body.

3. Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipate by or alternatively obvious over Obenchain (US Pat. 5,195,541).

As to claim 20, Obenchain (Fig. 5, for example) discloses shaver device 66 for cutting a tissue in a body cavity/distensible organ, fitting 51 for inflow irrigation, fitting 53 for outflow suction. Notice that device 66 has a separate suction passage through the tubular/hollow body of shaver 66. Alternatively, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the Obenchain device in a body cavity and naturally a body cavity is somewhat distensible when a positive pressure is applied from inside the body cavity or hollow organ to cut a tissue, as this device is disclosed to be used in a laparoscopic surgery. Notice that it is a common practice in laparoscopic surgery to have a positive pressure inside a body cavity for better view and easy manipulation of surgical instruments inside the inflated body cavity.

4. Claims 38, 61 and 69-71 are rejected under 35 U.S.C. 102(b) as being anticipate by Obenchain (US Pat. 5,195,541).

As to claims 38, 61 and 69-70, Obenchain (Fig. 5; col. 4, lines 5-34; for example) discloses shaver device 66 for cutting a tissue in a body cavity/distensible organ, fitting 51 for inflow irrigation, fitting 53 for outflow suction. Notice that device 66 has a separate suction passage through the tubular/hollow body of shaver 66.

As to claim 71, Obenchain (Fig. 5-6; col. 4, lines 5-34; for example) teaches suction passage 57 of substantially only fluid for regulating the pressure of a cavity body during a surgery operation.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Obenchain (US Pat. 5,195,541) in view of Grinberg (US Pat. 5,759,185).

Obenchain-'541 discloses substantially the claimed invention, including a well-known shaver 66. Obenchain-'541 does not explicitly disclose that shaver 66 is driven by a rotating motor. However, a shaver driven by a rotating motor is well known. Grinber-'185 (Fig. 4 and 6, for example) discloses cutter 50 and motor 92 to cut tissue. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a shaver 66 disclosed by Obenchain-'541 similar to a shaver disclosed by Grinberg-'185 to cut tissue as recited in the claim.

3. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Obenchain (US Pat. 5,195,541) in view of Savage (US Pat. 6,113,594).

Obenchain-'541 discloses substantially the claimed invention, except for a distensible body organ being enlarged by a fluid. Savage-'594 (Fig. 9, for example) discloses tube 62 for a fluid to be introduced into uterus U to enlarge the uterus U to facilitate a surgical procedure. It would have been obvious to one of ordinary skill in the art at the time the invention was made

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to introduce a fluid to a body organ to enlarge the body organ so that a surgical procedure can be conveniently conducted.

Allowable Subject Matter

Claims 22-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Amendment

The amendment and arguments filed on 12/07/2005 under 37 CFR 1.131 has been carefully considered but is moot in view of new rejection above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,


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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vy Q. Bui whose telephone number is 571-272-4692. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on 571-272-4959. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


06/11/2006

Vy Q. Bui
Primary Examiner
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